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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/497,006	02/02/2000	David R. Dempski	LUC-560	6965

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EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/497,006

Applicant(s)

DEMPSKI, DAVID R.

Examiner

Paul H Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka et al., US Pat. No. 6,366,298 B1, in view of Robinson, US Pat. No. 5,918,014 and further in view of Shear et al., US Pat. App. Pub. No. US 2003/0041239 A1.

3. As to claim 1, Haitsuka teaches a method for using a computer to gather information of an end user's visits to web pages and a duration of each visit (see Haitsuka, Summary and col. 5, line 23 – col. 6, line 3 and col. 6, line 34-45), the method comprising the steps of:

(a) monitoring the web pages the end user visits (see Haitsuka, col. 5, lines 23-43);

(b) recording the duration of each visit monitored in said step (a) (see Haitsuka, col. 2, lines 51-67 and col. 5, line 23 – col. 6, line 61);

(c) saving information recorded in said step (b) in the end user's computer (Haitsuka, col. 5, lines 23-43 and col. 8, line 6 – col. 9, line 62); and

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(e) uploading saved information upon selective operation by the end user from the end user's computer to a data processing computer, the information saved to the end user's computer in said step (c) (information is transmitted to the server upon certain user action; see Haitsuka, col. 2, lines 51-67 and col. 5, line 23 – col. 6, line 61 and col. 8, line 6 – col. 9, line 62).

However, Haitsuka does not explicitly teach the method comprising the steps of (b) recording the date of each visit monitored in said step (a). In the same field of endeavor, Robinson teaches a system for providing information regarding web page access including the date of last access (see Robinson, col. 1, line 27 – col. 2, line 62 and col. 12, lines 56-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the date of access information, as taught by Robinson, into the web page access monitoring system of Haitsuka, for the purpose of enhancing the accuracy and quality of the monitored user usage data.

Haitsuka-Robinson does not explicitly teach acquiring the end users' consent to upload saved information. In the analogous field of network computing security, Shear teaches a system and method for obtaining user consent prior to transmitting use metering data (Shear, [0009]-[0047] and [0074]-0077]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the security provisions as taught by Shear, into the metering system of Haitsuka-Robinson for the purpose of protecting private user information.

4. As to claim 3, Haitsuka-Robinson-Shear teach a method according to claim 2, further comprising the step of classifying a subject matter of each web page visited and recording the

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subject matter in said step (b) (see Haitsuka, col.6, lines 3-53).

5. Claims 4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka-Robinson-Shear, and further in view of Kunzinger et al., US Pat. No. 6,405,222 B1.

6. As to claim 4, Haitsuka-Robinson teach the invention substantially as claimed. Haitsuka-Robinson teach a method wherein the information saved in said step (c) is encrypted (see Haitsuka, col. 9, lines 53-62). However, Haitsuka-Robinson-Shear do not explicitly teach the use of compression techniques.

In the analogous art of distributed networking, Kunzinger teaches method of data compression for use in web based communications (Kunzinger, col. 9, lines 22-46).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the compression methods, as taught by Kunzinger, into the web page access monitoring system of Haitsuka-Robinson-Shear for the purpose of increasing data transfer efficiency, as well as for decreasing storage overhead.

7. As to claim 6, Haitsuka-Robinson-Shear-Kunzinger teach a method wherein the information saved in said step (c) is stored under an end user's user identification code (the user's personal profile, demographic information, as well as captured user interaction with web usage are unique to that user; see Haitsuka, col. 5, line 23 – col. 6, 53).

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8. As to claim 7, Haitsuka-Robinson-Shear-Kunzinger teach the invention substantially as claimed. However, Haitsuka-Robinson-Shear-Kunzinger, as previously applied, do not explicitly teach a method wherein the user identification code is an alpha-numeric character. However, Robinson does teach the use of an alpha-numeric user identification code (see Robinson, col. 9, line 65 – col. 10, line 29 and col. 13, line 65 – col. 14, line 32).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the method of storing information under an alpha-numeric user ID, as taught by Robinson, into the web page access monitoring system of Haitsuka-Robinson-Shear-Kunzinger as previously applied, for the purpose of enabling efficient data storage and retrieval.

9. Claims 8-9, 10-13, 15-18, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka-Robinson-Shear-Kunzinger, as applied above, and further in view of Davis et al., US Pat. No. 5,796,952.

10. As to claims 8 and 9, Haitsuka-Robinson-Shear-Kunzinger teach the invention substantially as claimed. However, Haitsuka-Robinson-Shear-Kunzinger do not explicitly teach a system and method wherein the step of uploading saved information upon selective operation by the end user further comprises:

requesting the end user to upload the saved information upon expiration of a user defined time interval, the saved information further includes URLs the user had previously visited and the duration of time the user has spent visiting the URLs;

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selecting to upload the saved information;
prompting the end user for its user identification code or user name;
inputting the end user information on the end user's computer; and
uploading the user identification code and the saved information to a data processing computer without receiving any information from the data processing computer to be displayed to the end user.

In the same field of endeavor, Davis teaches a system and method comprising requesting the end user to upload the saved information upon expiration of a user defined time interval, the saved information further includes URLs the user had previously visited and the duration of time the user has spent visiting the URLs; selecting to upload the saved information; prompting the end user for its user identification code or user name; inputting the end user information on the end user's computer; and uploading the user identification code and the saved information to a data processing computer without receiving any information from the data processing computer to be displayed to the end user (Davis, col. 1, line 16 – col. 3, line 67 and col. 4, line 3 – col. 5, line 56).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the method of saving and uploading information at predetermined times, as taught by Davis, into the system of Haitzuka-Robinson-Shear-Kunzinger for the purpose of reducing network traffic and latency.

11. Claims 10, 15-18, and 20-22 are a combination of the method steps of claims 1, 3-4, 6-9, and have similar limitations, except in method steps; therefore, claims 10, 15-18, and 20-22 are

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rejected under the same rationale.

12. As to claim 11, Haitsuka-Robinson-Shear-Kunzinger-Davis teach wherein monitored information is paired with an end user's identification code (Haitsuka, col. 6, lines 4-61; and Davis, col. 1, line 16 – col. 3, line 67 and col. 4, line 3 – col. 5, line 56).

13. As to claims 12 and 13, Haitsuka-Robinson-Shear-Kunzinger-Davis teach the computer wherein the processor passively monitors TCP/IP stack protocol or monitors the web browser cache to retrieve the monitored information (Davis, col. 1, line 16 – col. 3, line 67 and col. 4, line 3 – col. 5, line 56).

14. Claims 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka-Robinson-Shear-Kunzinger-Davis and further in view of Thomas., US Pat. No. 6,128,663.

15. As to claim 14, Haitsuka-Robinson-Shear-Kunzinger-Davis teach the invention substantially as claimed. However, Haitsuka-Robinson-Shear-Kunzinger-Davis do not explicitly teach the computer wherein the monitored information is compressed and encrypted before being uploaded. In the same field of endeavor, Thomas teaches encrypting and compressing demographic information (See Thomas, col. 11, line 18 – col. 12, line 22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the encryption and compression as taught by Thomas into the system of Haitsuka-

Robinson-Shear-Kunzinger-Davis for the purpose of enhancing security features to prevent dissemination of private information.

16. As to claim 19, Haitsuka-Robinson-Shear-Kunzinger-Davis-Thomas teach the invention substantially as claimed. Haitsuka-Robinson-Shear-Kunzinger-Davis-Thomas teach a method wherein the demographic data comprises the end user's age, sex, and address, among others (see Haitsuka, col. 5, line 59 – col. 6, line 3). However, Haitsuka-Robinson-Shear-Kunzinger-Davis-Thomas does not explicitly teach that the demographic data additionally comprises of ethnicity, nationality and physical disability.

Official Notice is taken (MPEP 2144.03) that demographic data such as ethnicity, nationality and physical disability were well known in the art at the time the invention was made. As exemplified by Shuman et al., US Pat. No. 6,161,071, Sutcliffe et al, US Pat. No. 6,249,282 B1, and Sone, US Pat. App. Pub. No. US 2002/0035560 A1, cited as relevant prior art but not relied upon, ethnicity, nationality and physical disability fall within categories of demographic data as was well known and widely accepted in the art. Additionally, these types of personal profiles are within the scope of Haitsuka-Robinson-Shear-Kunzinger-Davis-Thomas' teachings (See Haitsuka, col. 5, line 23 – col. 6, line 17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated demographic data such as ethnicity, nationality and physical disability, as was well known in the art, into web page access monitoring system of Haitsuka-Robinson-Shear-Kunzinger-Davis-Thomas for the purpose enhancing the

customization and personalization of data reach.

Response to Arguments

17. Applicant's arguments with respect to claims 1, 3-4 and 6-22 have been considered but are not persuasive. The Applicant argued in substance that:

a. Haitsuka fails to teach "acquiring the end users' consent to upload saved information; and uploading saved information upon selective operation by the user...", "requesting the end user to upload the saved information upon expiration of a user defined time interval, the saved information further including URLs the user has previously visited and the duration of time the user has spent visiting these URLs." Remarks, page 12, lines 1-8; "uploading information without receiving any information from the data processing computer to be displayed to the end user," (Remarks, page 12, lines 14-15 and page 17, line 1 – page 18, line 3).

As to point a), applicant argues that Haitsuka alone fails to teach the above cited elements. However, those elements were indicated as being taught by the prior art in combination with Haitsuka. For instance, Shear teaches the user consent and Davis teaches a time interval among other elements. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

b. Applicants disagree with the Examiner as to whether Shear teaches a “method of obtaining user consent prior to transmitting use metering data.” Remarks, page 13, lines 17-20.

As to point b), Examiner respectfully disagrees. Shear, in combination with the other cited references, teach obtaining user consent to transmit information from a user computer to a server computer. Shear is geared toward preventing unauthorized access to user computers (See Shear, paragraphs 0009-0010, 0017-0022). Although Shear is capable of automatically authorizing “executables,” Shear also provides for manual authorization, wherein a user provides permission to access data (Shear, 0037-0040).

c. Applicants argue that there is no motivation to combine Shear with Haituka and Robinson.

As to point c), in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Haituka and Robinson teach a system wherein a script is downloaded to a user's computer to perform a task. This process inherently creates security concerns. In the same field of endeavor, Shear

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teaches a system and method for authorizing remote users' access to a local system for the purpose of enhancing security and privacy.

d. "Unlike Kunzinger, the present invention compresses and encrypts information monitored and saved at an end user's system... Kunzinger does not suggest and does not teach compression and encryption in the manner claimed in claim 4." Remarks, page 15, lines 8-18.

As to point d), the compression techniques taught by Kunzinger is not limited for use apart from the user's system. On the contrary, a compression technique can be applied any applicable data item. Kunzinger was relied upon for the teachings of compression techniques in order to apply to the encrypted data of Haitzuka-Robinson-Shear for the purpose of increasing data transfer efficiency and decreasing storage overhead.

e. The prior art of record "does not teach and does not suggest ensuring privacy by uploading saved information containing a user identification code that relates to the end user's demographic information stored at a data processing system," and related limitations regarding the identification code. Remarks, page 15, line 19 – page 16, line 11.

As to point e), contrary to Applicants' arguments, the prior art of record teaches a user identification that relates to the end user's demographic information. In the prior art, a user's personal profile, demographic information, and captured user usage data, are

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stored under the user's unique identification (See *Haitsuka*, col. 5, line 23 – col. 6, line 53). Clearly, the user's identification is related to the stored demographic information.

f. “Unlike Thomas, the present invention not only does not compress demographic information, it does not upload demographic information over the network.”

As to point f), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., off-line supply of demographic information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

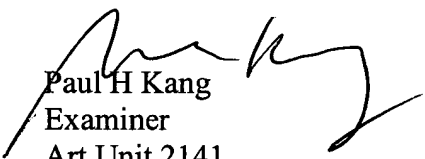
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Paul H Kang
Examiner
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